



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/371,537	08/10/1999	HIROFUMI SUDA	35.C13723	9383

5514 7590 06/04/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

VU, NGOC K

ART UNIT PAPER NUMBER

2611

DATE MAILED: 06/04/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/371,537

Applicant(s)

SUDA ET AL.

Examiner

Ngoc K. Vu

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/23/2004 has been entered.

Response to Arguments

2. Applicant's arguments filed 3/23/2004 have been fully considered but they are not persuasive.

Applicant argues that Ito does not teach or suggest "communication unit has a decoding unit and an encoding unit arranged and operating as recited in claim 22". This argument is not persuasive.

As shown in figure 9 of the Ito reference, a device 902 receives/transmits data from/to a device 901. It is noted that the device 901 is a digital camera/camcorder for capturing image/video (see col. 19, lines 36-47). Ito further shows that the device 902 comprises a 1394 interface 1202, a data conversion unit 1203 and a wireless interface 309 in figure 12. Ito clearly discloses that the data conversion unit 1203 converts the image/video data, wireless transmitted from the wireless interface 309, into a data format based on the IEEE 1394 standard, for supply to the 1394 interface 1202, which outputs the image/video data from device 901 to the communication system 203-204. The device 902 is also capable, of transferring the image/video data, transmitted from a predetermined device on the communications system 203-204, to the

Art Unit: 2611

device 901 (see figures 9 and 12; col. 20, lines 8-14 and 50-54). The image/video data transmitted from the device 901 are supplied from the wireless interface 309 to the 1394 interface 1202 via the data conversion unit 1203, and are converted into a packet of a communication method based on the IEEE 1394 standard. The packet outputted from the 1394 interface 1202 is transferred to all the devices on the communication system (see col. 22, lines 1-7).

Thus, Ito teaches that the 1394 interface 1202, the data conversion unit 1203 and the wireless interface 309 of the device 902 perform the image/video data conversion utilizing the predetermined communication protocol in such a manner that the image/video data can be transferred between the device on the communication system and the device 901 via the device 902. In detail, the device 902 inherently comprises "a decoding unit" for decoding the encoded image/video data, which encoded by device 901 in wireless communication protocol, into decoded image/video data, and "an encoding unit" for encoding the decoded image/video data into encoded image/video data in IEEE 1394 protocol to transmit the encoded image/video data in IEEE 1394 protocol to the device on the communication system. In reverse, the device 902 comprises "a decoding unit" for decoding the encoded image/video data, which encoded by device on the communication system in IEEE 1394 protocol, into image/video data, and "an encoding unit" for encoding the decoded image/video data into encoded image/video data in wireless communication protocol to transmit the encoded image/video data in wireless communication protocol to the device 901.

With respect to claim 22, the device 902 ("communication apparatus") includes the data conversion unit 1203 and the wireless interface 309 ("decoding unit") for decoding the encoded image/video data in wireless communication protocol received from the device 901 into decoded image/video data, and the data conversion unit 1203 and 1394 interface 1202 ("encoding unit")

Art Unit: 2611

for encoding the decoded image/video data into encoded image/video data in IEEE 1394 protocol for transmitting the encoded image/video data in IEEE 1394 protocol to the device on the communication system.

Thus, Ito discloses the communication unit that has a decoding unit and an encoding unit arranged and operating as recited in claim 22. Similar interpretations in claim 22 above are addressed for claims 25 and 28.

With respect to claim 31, the limitations include the communication unit comprising "a decoding unit is adapted to decode the second encoded video data into video data", and "a encoding unit is adapted to encode the video data into first encoded video data using a first encoding system". Similar interpretations above, the device 902 ("communication apparatus") includes the data conversion unit 1203 and the wireless interface 309 ("decoding unit") for decoding the encoded image/video data in IEEE 1394 protocol received from the device on the communication system into decoded image/video data, and the data conversion unit 1203 and the wireless interface 309 ("encoding unit") for encoding the decoded image/video data into encoded image/video data in wireless communication protocol for transmitting the encoded image/video data in wireless communication protocol to the device 901.

Similar interpretations in claim 31 above are addressed for claims 34 and 37.

For the above reasons, it is believed that the rejections for claims 22-39 should be sustained.

Claim Objections

3. Claims 22-24 objected to because of the following informalities: claim 22 recites the limitations "the encoding unit is adapted to decode the first encoded video data into video data". It seems the limitation "encoding unit" to refer to "decoding unit" since decoding unit or decoder

Art Unit: 2611

is adapted to decode the encoded video data. For purpose of examination, the limitation is read as "decoding unit". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 23, 24, 26, 27, 29, 30, 32, 33, 35, 36, 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23, 24, 26, 27, 29, 30, 33, 36 and 39 recite the limitation "the second data" in line

4. There is insufficient antecedent basis for this limitation in the claims.

Claims 32, 33, 35, 36, 38 and 39 recite the limitation "the first video" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 32, 35 and 38 recite the limitation "the second data" in line 5. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2611

7. Claims **22-39** are rejected under 35 U.S.C. 102(e) as being anticipated by Ito et al. (US 6,529,522 B1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding **claim 22**, Ito et al. disclose a communication system (902 - see figure 9) comprising:

a first apparatus in a wireless network (apparatus 901 in wireless communication - see figure 9);

a second apparatus in a wired network (device(s) on the communication system 203-204 in serial bus IEEE 1394 - see figure 9); and

a communication apparatus (apparatus 902 - see figure 9) arranged to communicate with the first apparatus (apparatus 901), and is arranged to communicate with the second apparatus (203-204 - see figure 9),

wherein the communication apparatus includes a first communication unit (i.e., wireless interface 309 - see figure 12), a decoding unit (309 and 1203 - see figure 12), an encoding unit (1202 and 1203 - see figure 12), and a second communication unit (i.e., 1394 interface 1202 - see figure 12),

wherein the first communication unit (309) is adapted to receive first encoded video data encoded by a first encoding system and transmitted from the first apparatus (the wireless

Art Unit: 2611

interface 309 receives encoded image/video data in wireless communication protocol transmitted from device 901 – see col. 18, lines 25-27; col. 22, lines 1-3; and figure 12);

wherein the decoding unit (1203 and 309 – see figure 12) is adapted to decode the first encoded video data into video data (the data conversion unit 1203 and the wireless interface 309 are adapted to decode the received encoded image/video data into decoded image/video data - see col. 20, lines 8-14; col. 22, lines 1-4; and figure 12),

wherein the encoding unit (1203 and 1202 – see figure 12) is adapted to encode the video data into second encoded video data using a second encoding system (the data conversion unit 1203 and 1394 conversion unit are adapted to encode the decoded image/video data into encoded image/video data in IEEE 1394 protocol – see col. 20, lines 8-14; col. 22, lines 5-10; and figure 12),

wherein the second communication unit (1202 – figure 12) is adapted to transmit the second encoded video data to the second apparatus (the 1394 interface 1202 is adapted to supply the encoded image/video data in IEEE 1394 protocol to device(s) on the communication system 203-204 – see col. 20, lines 8-14 and figure 12; col. 22, lines 5-10).

Regarding **claim 23**, Ito et al. disclose a communication system according to claim 22, wherein the first apparatus is a video camera (apparatus 901 is a digital camera – see figure 9; col. 18, lines 19-22), and the second apparatus is an apparatus adapted to record the second video data on a recording medium (it is noted that apparatus PC 203 includes a hard disk or hard drive for recording or storing the received image/video data – see figure 9; col. 19, lines 49-48).

Regarding **claim 24**, Ito et al. disclose a communication system according to claim 22, wherein the first apparatus is a video camera (apparatus 901 is a digital camera – see figure 9; col. 18, lines 19-22), and the second apparatus is an apparatus adapted to display the second

Art Unit: 2611

video data (it is noted that the apparatus PC 203 includes a monitor for displaying the image/video data - see figure 9; col. 19, lines 49-48).

Regarding **claim 25**, Ito et al. disclose a communication apparatus (i.e. apparatus 902 - see figure 9) that is arranged to communicate with a first apparatus in a wireless network (i.e., device 901 in wireless communication - see figure 9) and is arranged to communicate with a second apparatus in a wired network (i.e., apparatus 203-204 in serial bus - see figure 9), the communication apparatus comprising:

- a first communication unit (i.e., wireless interface 309 - see figure 12) adapted to receive a first encoded video data encoded by a first encoding system and transmitted from the first apparatus (the wireless interface 309 receives encoded image/video data in wireless communication protocol transmitted from device 901 - see col. 18, lines 25-27; col. 22, lines 1-3; and figure 12);

- a conversion unit (i.e., data conversion unit 1203 - see figure 12) adapted to convert the first encoded video data into second video data encoded by a second encoding system (the data conversion unit 1203 converts the encoded image/video data into a data format based on the IEEE 1394 standard - see col. 20, lines 8-11);

- a decoding unit (309 and 1203 - see figure 12), adapted to decode the first encoded video data into video data (the data conversion unit 1203 and the wireless interface 309 are adapted to decode the received encoded image/video data into decoded image/video data - see col. 20, lines 8-14; col. 22, lines 1-4; and figure 12);

- an encoding unit (1203 and 1202 - figure 12), adapted to encode the video data into the second encoded video data using the second encoding system (the data conversion unit 1203 and 1394 conversion unit are adapted to encode the decoded image/video data into encoded

Art Unit: 2611

image/video data in IEEE 1394 protocol – see col. 20, lines 8-14; col. 22, lines 5-10; and figure 12); and

a second communication unit (i.e., 1394 interface 1202 – see figure 12) adapted to transmit the second encoded video data to the second apparatus (the 1394 interface 1202 is adapted to supply the encoded image/video data in IEEE 1394 protocol to device(s) on the communication system 203-204 – see col. 20, lines 8-14 and figure 12; col. 22, lines 5-10).

Regarding **claim 26**, Ito et al. disclose a communication apparatus according to claim 25, wherein the first apparatus is a video camera (apparatus 901 is a digital camera – see figure 9; col. 18, lines 19-22), and the second apparatus is an apparatus adapted to record the second video data on a recording medium (it is noted that apparatus PC 203 includes a hard disk or hard drive for recording or storing the received image/video data – see figure 9; col. 19, lines 49-48).

Regarding **claim 27**, Ito et al. disclose a communication apparatus according to claim 25, wherein the first apparatus is a video camera (apparatus 901 is a digital camera – see figure 9; col. 18, lines 19-22), and the second apparatus is an apparatus adapted to display the second video data (it is noted that the apparatus PC 203 includes a monitor for displaying the image/video data - see figure 9; col. 19, lines 49-48).

Claims **28-30** recite a communication method having the same limitations as recited in claims 25-27. Therefore, they are rejected for the same reasons as claims 25-27. Please see the rejections of claims 25-27 above.

Regarding **claim 31**, Ito et al. disclose a communication system (see figure 9) comprising:

a first apparatus in a wireless network (i.e., apparatus 901 in wireless communication – see figure 9);

Art Unit: 2611

a second apparatus in a wired network (i.e., apparatus 203-204 in serial bus IEEE 1394 – see figure 9); and

a communication apparatus (i.e., apparatus 902 – see figure 9) that is arranged to communicate with the first apparatus (901) and arranged to communicate with the second apparatus (203-204 – see figure 9),

wherein the communication apparatus includes a first communication unit (i.e., wireless interface 309 – see figure 12), a decoding unit (309 and 1203 – see figure 12), an encoding unit (1202 and 1203 – see figure 12), and a second communication unit (i.e., 1394 interface 1202 – see figure 12),

wherein the second communication unit (1202 – see figure 12) is adapted to receive a second encoded video data encoded by a second encoding system and transmitted from the second apparatus (the 1394 interface 1202 is adapted to receive an encoded image/video data in IEEE 1394 protocol and transmitted from the device on communication system 203-204 – see col. 20, lines 8-14 and 42-54; figure 12),

wherein the decoding unit (1202 and 1203 – see figure 12) is adapted to decode the second encoded video data into video data (the 1394 interface 1202 and data conversion unit 1203 are adapted to decode the encoded image/video data into decoded image/video data – see col. 20, lines 50-54 and figure 12),

wherein the encoding unit (1203 and 309 – see figure 12) is adapted to encode the video data into first encoded video data using a first encoding system (the data conversion unit 1203 and the wireless interface 309 are adapted to encode the decoded image/video data into encoded image/video data in wireless communication protocol - see col. 20, lines 50-54 and figure 12), and

wherein the first communication unit (309 – see figure 12) is adapted to transmit the first encoded video data to the first apparatus (the wireless interface 309 transmits the encoded image/video data in wireless communication protocol to the apparatus 901 - see col. 20, lines 50-54 and figure 12).

Regarding **claim 32**, Ito et al. disclose a communication system according to claim 31, wherein the first apparatus is an apparatus adapted to record the first video apparatus on a recording medium (i.e., apparatus 901) adapted to record the received video data on a recording medium (i.e., via 304 and 1201 – see figure 12; col. 20, line 65 to col. 21, line 5), and the second apparatus is an apparatus adapted to reproduce the second video data from a recording medium (for example, PC 203 may reproduces the image/video data from the recording medium, i.e., hard disk or hard drive. It is noted that the apparatus 902 supports plural communication protocols for transferring the image/video data for display, recording from/to apparatus 901 to/from a communication system 203-204 – see col. 20, lines 8-14 and 42-54; figure 12).

Regarding **claim 33**, Ito et al. disclose a communication system according to claim 31, wherein the first apparatus is an apparatus adapted to display the first video data (the apparatus 901 includes a display unit 307 for displaying the received image data – see figure 12; col. 21, lines 16-19), and the second apparatus is an apparatus adapted to reproduce the second video data from a recording medium (for example, PC 203 may reproduces the image/video data from the recording medium, i.e., hard disk or hard drive. It is noted that the apparatus 902 supports plural communication protocols for transferring the image data for display, recording from/to apparatus 901 to/from a communication system 203-204 – see col. 20, lines 8-14 and 42-54; figure 12).

Art Unit: 2611

Regarding **claim 34**, Ito et al. disclose a communication apparatus (902- see figure 9) that is arranged to communicate with a first apparatus in a wireless network (i.e., apparatus 901 in wireless communication – see figure 9) and arranged to communicate with a second apparatus in a wired network (i.e., apparatus 203-204 in serial bus IEEE 1394 – see figure 9), the communication apparatus comprising:

a second communication unit (1394 interface 1202 – see figure 12) adapted to receive a second encoded video data encoded by a second encoding system and transmitted from the second apparatus (the 1394 interface 1202 is adapted to receive an encoded image/video data in IEEE 1394 protocol and transmitted from the device on communication system 203-204 – see col. 20, lines 8-14 and 42-54; figure 12);

wherein the decoding unit (1202 and 1203 – see figure 12) is adapted to decode the second encoded video data into video data (the 1394 interface 1202 and data conversion unit 1203 are adapted to decode the encoded image/video data into decoded image/video data – see col. 20, lines 50-54 and figure 12),

wherein the encoding unit (1203 and 309 – see figure 12) is adapted to encode the video data into first encoded video data using a first encoding system (the data conversion unit 1203 and the wireless interface 309 are adapted to encode the decoded image/video data into encoded image/video data in wireless communication protocol - see col. 20, lines 50-54 and figure 12), and

wherein the first communication unit (309 – see figure 12) is adapted to transmit the first encoded video data to the first apparatus (the wireless interface 309 transmits the encoded image/video data in wireless communication protocol to the apparatus 901 - see col. 20, lines 50-54 and figure 12).

Regarding **claim 35**, Ito et al. disclose a communication apparatus according to claim 34, wherein the first apparatus is an apparatus adapted to record the first video apparatus on a recording medium (i.e., apparatus 901) adapted to record the received video data on a recording medium (i.e., via 304 and 1201 – see figure 12; col. 20, line 65 to col. 21, line 5), and the second apparatus is an apparatus adapted to reproduce the second video data from a recording medium (for example, PC 203 may reproduces the image/video data from the recording medium, i.e., hard disk or hard drive. It is noted that the apparatus 902 supports plural communication protocols for transferring the image data for display, recording from/to apparatus 901 to/from a communication system 203-204 – see col. 20, lines 8-14 and 42-54; figure 12).

Regarding **claim 36**, Ito et al. disclose a communication apparatus according to claim 34, wherein the first apparatus is an apparatus adapted to display the first video data (the apparatus 901 includes a display unit 307 for displaying the received image/video data – see figure 12; col. 21, lines 16-19), and the second apparatus is an apparatus adapted to reproduce the second video data from a recording medium (for example, PC 203 may reproduces the image data from the recording medium, i.e., hard disk or hard drive. It is noted that the apparatus 902 supports plural communication protocols for transferring the image data for display, recording from/to apparatus 901 to/from a communication system 203-204 – see col. 20, lines 8-14 and 42-54; figure 12).

Claims **37-39** recite a communication method having the same limitations as recited in claims 34-36. Therefore, they are rejected for the same reasons as claims 34-36. Please see the rejections of claims 34-36 above.

Art Unit: 2611

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu
Examiner
Art Unit 2611

May 27, 2004